

AMMERMANN et al
S.N: 10/506502
OA October 17, 2005

REMARKS:

Claims 1-9 are currently pending. No Claims have been amended. No new material has been added. A supplemental IDS is attached hereto on separate sheets to provide additional information for the citations crossed out by the Examiner.

Claims rejected under 35 USC § 103

Claims 1, 3 and 5-9 are rejected for allegedly being obvious in view of US 2004/0186141. Applicants respectfully disagree.

To establish *prima facie* obviousness, the Examiner must show in the prior art some suggestion or motivation to make the claimed invention, a reasonable expectation for success in doing so, and a teaching or suggestion of each Claim element (*see, e.g., In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986); *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)).

The Examiner has not made the required showing.

Since the above mentioned cited art relies on the filing date of a provisional application to precede the priority date of the instant application, Applicants hereby request a copy of said provisional application to determine if the disclosure of the provisional application is the same as that of the published application.

US 2004/0186141 discloses a pyrazole-3-carboxamide of formula I. Dissimilarly, the instant invention discloses a prothioconazole of formula I and a chlorpyrifos of formula III. Moreover, the cited art recites on page 18, paragraph [0115], that the inventive compounds can be mixed with "other biologically active compounds or agents including insecticides, fungicides, nematocides, bactericides, acaricides..." which while disclosing both prothioconazole and chlorpyrifos fails to teach a mixture of two compounds from said list. Accordingly, whereas the cited art requires a mixture of the inventive compound and a second compound from the recited list, the instant invention teaches a combination of prothioconazole and chlorpyrifos. Merely disclosing the formulae of the instant invention in a list for combination with a second other compound does not provide one of ordinary skill in the art the motivation to perform the instant invention expecting successful results.

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Moreover, Applicants disagree with the Examiner assertion that the instant invention fails to disclose synergism. The Examiner is directed to page 11, table 2, wherein four examples of said synergism are disclosed. These synergistic effects are based on differing mixture ratios of prothioconazole and chlorpyrifos. Thus, contrary to the Examiner's statement, the instant combination of prothioconazole and chlorpyrifos does provide synergism.

For at least the reasons expressed above, it is urged that the prior art references cited by the examiner combination fails to anticipate or suggest the present invention as defined by the Claims. Accordingly, a *prima facie* case of obviousness has not been established by the Examiner, and the rejection under 35 USC § 103 should be withdrawn. Favorable action is solicited.